UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/903,743	07/31/1997	TIMOTHY MERRICK LONG	169.0568	2593

5514   7590   09/27/2004

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EXAMINER
PAULA, CESAR B

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _11 May 2004_ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,3,4,7,9-12,27-29,31-33,38 and 42-56_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-56_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6)☐ Other: .

DETAILED ACTION

1.   This action is responsive to the amendment filed on 5/11/2004.

This action is made Non-Final.

2.   In the amendment, claims 54-56, have been added. Claims 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-56 are pending in the case. Claims 1, 27-29, 31, 38, and 54-56 are independent claims.

3.   The rejections of claims 1, 3-4, 7, 9-12, 22, 27-29, 31, 38, 42-53 under 35 U.S.C. 103(a) as being unpatentable over Nehab et al, hereinafter Nehab (Pat. # 6,029,182, 2/22/00, filed on 10/4/96) have been withdrawn as necessitated by the newly found prior art.

4.   The rejections of claims 32-33 under 35 U.S.C. 103(a) as being unpatentable over Nehab, and further in view of Hayashi et al (Pat. # 5,633,996, 5/27/97, filed on 11/8/94) have been withdrawn as necessitated by the newly found prior art.

Drawings

5.   This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 1, 3-4, 7, 9-12, 22, 27-29, 31, 38, 42-56 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Nehab et al, hereinafter Nehab (Pat. # 6,029,182, 2/22/00, filed on

10/4/96), in view of Savitzky et al, hereinafter Savitzky (Pat. # 6,012,083, 1/4/2000, filed on

9/24/1996).

        Regarding independent claim 1, Nehab teaches the creation, by a of a personalized

document. This document is created by collating and arranging various stand alone web pages of

different newspapers articles into a single linear or continuous printable document. A "site

driver" is used for monitoring url addresses or commands entered by a user into a profile editor--

second application-- while navigating a network web pages—*accessing plurality of hyper-text*

documents and formatting information, and records them in a log for the later retrieval, and

formatting into a single linear document of all the exact documents accessed by the user (c.3,

L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67). Nehab fails to explicitly disclose: *(a) monitoring a*

second application operating independently of said first application on said local machine, to

identify the plurality of hyper-text documents accessed independently by the second application.

However, Savitzky teaches an independent agent for providing a history of all the document

accessed by a client (col.3, lines 45-67, abst., fig.1). It would have been obvious to a person of

ordinary skill in the art at the time of the invention to have combined Nehab, and Savitzky, and

have monitored the second application--client, because Savitzky teaches avoiding providing

agents that are independent of the client and server (col. 3, lines 1-26, col.4, lines 16-32). This

provides the benefit of providing a agent that is flexible, and does not depend or is tied down to

either the client or server.

Moreover, Nehab teaches the recording of selected hyperlinks portions or articles of

webpages into a log using the articles' address or format information (c.3, L.15-c.4,L.67,

c.8,L.34-67).

Furthermore, Nehab teaches the retrieving, and formatting of the various web pages using

the address/location—*formatting information*, and/or articles of different newspapers into a

single printable document, where the various newspapers are contiguously laid out (c.3, L.15-

c.4,L.67, c.9,L.40-63).

Regarding claim 3, which depends on claim 1, Nehab teaches the creation, by a stand

alone *first application*, of a personalized document by collating and arranging various web pages

of different newspapers articles into a single linear or continuous printable document (c.3, L.15-

c.4,L.67, c.9,L.40-62). Nehab fails to explicitly disclose: ....*the printable document is updated*

upon new hyper-text pages being accessed by the second application. However, it would have

been obvious to a person of ordinary skill in the art at the time of the invention to have updated

the document, because Nehab teaches the duplication of user's selection criteria in clicking on

hyperlinks in a web site (col. 8, lines 34-67). This provides the benefit of automatically, and

interactively reproducing user's selection of hyperlinks, while avoiding time consuming manual update of the document.

Regarding claim 4, which depends on claim 1, Nehab teaches a tracking program for the monitoring of url addresses or commands entered by a user while navigating a network web pages (c. 8,L.34-67)-- ....*said steps are performed in a background mode relative to the user's access to the hyper-text documents*.

Regarding claim 7, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document of multiple columns (c.14, L.47, and c.16,L.1-67).

Regarding claim 9, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document with an index, and table of contents of the links to articles source links in the web pages (c.14, L.47-67, and c.15,L.20-c.16,L.67)--....*the printable document comprises a table of contents listing each hyper-text document ....*

Regarding claim 10, which depends on claim 1, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink references to the articles' sources --....*hyper-link index of at least one hyper link reference ...* (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 11, which depends on claim 10, Nehab discloses formatting different

newspaper articles into a single printable document with hyperlink cross-references to an index -

-.... *each hyper-link reference in the printable document is tagged with a cross reference to a*

corresponding entry ... (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 12, which depends on claim 10, Nehab discloses including all hyperlink

references of each article represented in the formatted document .... *said hyper-link index*

comprises all hyper-link references of each hyper-text ....--(c.6, L.58-c.7,L.67, and c.15,L.20-

c.16,L.67).

Claim 22 is directed towards a method for carrying out the steps found in claim 12, and

therefore are similarly rejected.

Regarding independent claim 27, Nehab teaches the creation, by a stand alone *first*

application in a local computer, of a personalized document by collating and arranging various

web pages, from websites--*sources*, of different newspapers articles into a single linear or

continuous printable document according to the size of the respective articles (c.3, L.15-c.4,L.67,

c.13,L.12-67, fig. 9A). Nehab fails to explicitly disclose: *monitoring accesses by the second*

application to the plurality of documents in sequence. However, it would have been obvious to a

person of ordinary skill in the art at the time of the invention to have monitored the second

application--browser, because Nehab teaches the duplication of user's selection criteria in

clicking on hyperlinks in a web site (col. 8, lines 34-67). This provides the benefit of automatically, and interactively monitoring user's selection of hyperlinks, while interacting with only one application—the browser—instead of manually interacting with both the browser and the web reader to input user's browsing preferences.

Moreover, Nehab teaches the recording of selected hyperlinks of portions or articles of webpages into a log using the articles' address or format information (c.3, L.15-c.4,L.67, c.8,L.34-67).

Furthermore, Nehab teaches the retrieving, and formatting of the various web pages according the address/location—*formatting information*, and/or articles of different newspapers—*size information*-- into a single printable document, where the various newspapers are contiguously laid out (c.3, L.15-c.4,L.67, c.9,L.40-63).

Claim 28 is directed towards a computer system for carrying out the steps found in claim 27, and is similarly rejected.

Claim 29 is directed towards a computer readable medium for storing the steps found in claim 1, except for the retrieval of documents from a network which is taught by Nehab (col.8, lines 33-67, fig.4), and is similarly rejected.

Claim 31 is directed towards a computer program product having a computer readable medium for storing the steps found in claim 1, and is similarly rejected.

Claim 38 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 27, and is similarly rejected.

Claims 42-45 are directed towards a method for forming a single printable documents for carrying out the steps found in claim 1, and therefore are similarly rejected

Claims 46-47 are directed towards a computer program product having a computer readable medium for storing the steps found in claim 1, and therefore are similarly rejected.

Regarding independent claim 48, Nehab teaches the creation, by a of a personalized document. This document is created by collating and arranging various stand alone web pages of different newspapers articles into a single linear or continuous printable document. A "site driver" is used for monitoring url addresses or commands entered by a user into a profile editor-- *second application*-- while navigating a network web pages—*accessing plurality of hyper-text documents and formatting information*, and records them in a log for the later retrieval, and formatting into a single linear document of all the exact documents accessed by the user (c.3, L.15-c.4,L.67, c. 8,L.34-67, c.7,L.57-67, c.9,L.62-c.10,L.21). Nehab fails to explicitly disclose: *displaying the list of the plurality of documents*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have displayed the list of documents, because this would have enabled the user to edit the list of documents according to user's preferences, and taste as suggested above.

Moreover, Nehab fails to explicitly disclose: *fetching independently of the second application each document selected from the list and formatting.* However, Savitzky teaches an independent agent for providing a history of all the document accessed by a client (col.3, lines 45-67, abst., fig.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Nehab, and Savitzky, and have monitored the second application--client, because Savitzky teaches avoiding providing agents that are independent of the client and server (col. 3, lines 1-26, col.4, lines 16-32). This provides the benefit of providing a agent that is flexible, and does not depend or is tied down to either the client or server.

Furthermore, Nehab teaches the a graphical user interface for editing the document list or profile, and formatting of the various web pages according to user's dictates (c.9, L.35-67).

Claim 49 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 48, and is similarly rejected.

Regarding claim 50, which depends on claim 48, Nehab teaches the creation of a personalized document by retrieving, collating—*compiling*-- and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.10,L.21-44).

Claims 51-53 are directed towards a computer program product having a computer readable medium for storing the steps found in claims 48-50, and therefore are similarly rejected.

Claim 54 is directed towards a method for forming the print list for found in claim 1, and is similarly rejected.

Claim 55 is directed towards an apparatus for carrying out the steps found in claim 1, and is similarly rejected.

Claim 56 is directed towards a computer program product having a computer readable medium for storing the steps found in claim 1, and is similarly rejected.

8.   Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab, in view of Savitzky, and further in view of Hayashi et al (Pat. # 5,633,996, 5/27/97, filed on 11/8/94).

Regarding claim 32, which depends on claim 7, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose: *....maximizing the number of hyper-text documents on each page......* However, Hayashi et al disclose: "....searching an area for display or printing to which the contents of the document can be laid out......" (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Nehab, Savitzky, and

Hayashi et al, because Hayashi et al teach above search of printable or displayable space the

automatic layout of a structured document into a multicolumn document.

Regarding claim 33, which depends on claim 32, Nehab teaches the creation of a

personalized document by collating and arranging various web pages of different newspapers

into a single printable document (c.3, L.15-c.4,L.67). Nehab fails to explicitly disclose:

....determining if space exists on a page of the printable document.....if so, inserting the

formatted hyper-text document...... However, Hayashi et al disclose: "….searching an area for

display or printing to which the contents of the document can be laid out……" (Col. 3, lines 7-

24). It would have been obvious to a person of ordinary skill in the art at the time of the

invention to had combined the teachings of Nehab, Savitzky, and Hayashi et al, because Hayashi

et al teach above search of printable or displayable space the automatic layout of a structured

document into a multicolumn document.

Response to Arguments

9.   Applicant's arguments with respect to claims 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-53

have been considered but are moot in view of the new ground(s) of rejection. The Applicant state

that the benefit suggested in the office action is not one that is taught by Nehab (p.26,L.19-22).

Upon a closer look at the claims and the prior art, the claims have been rejected as indicated

above. The Applicants are referred to these rejections of the newly added features as noted

above.

Moreover, applicants indicates that Hayashi fails to remedy the shortcomings of Nehab

(page 30, lines 14-15). The Applicants are referred to these rejections of the newly added

features as noted above.

10.   Applicant's arguments filed 5/11/2004 have been fully considered but they are not

persuasive. Applicants note that there is no need for displaying documents. The examiner

disagrees, because it would have been obvious to a person of ordinary skill in the art at the time

of the invention to have displayed the list of documents, because this would have enabled the

user to edit the list of documents according to user's preferences, and taste as suggested by

Nehab (col.9, line 62-col.10, line20).

Conclusion

I.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Cesar B. Paula whose telephone number is **(703) 306-5543 ((571) 272-**

2148 as of 10/12/04). The examiner can normally be reached on Monday through Friday from

8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Stephen Hong, can be reached on (703) 308-5465 ((571) 272-4124 as of 10/12/04). However, in

such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should

be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- **(703) 703-872-9306,** (for **all** Formal communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

CESAR B PAULA
Patent Examiner
Art Unit 2178

9/20/04